PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

Application No.	:10/572,953	Confirmation No.:4797
Applicant	: Dietmar Birgel et al	
Filed	: March 22, 2006	
Title	: CIRCUIT BOARD WITH HOLDING MECHANISM FOR HOLDING WIRED ELECTRONIC COMPONENTS, METHOD FOR MANUFACTURING OF SUCH CIRCUIT BOARD AND THEIR USE IN A SOLDERING OVEN	
TC/A.U.	: 2833	
Examiner	: T.S. Chambers	
Docket No.	: BIRG3005 /FJD	
Customer No.	: 23364	

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22202-3514

Sir:

INTRODUCTORY COMMENTS

Pursuant to the provisions of 37 CFR 41.41, submitted herewith is Applicant/Appellant's Reply Brief on Appeal.

EXAMINER'S ANSWER

In applying Belke, Jr. et al under 35 USC 102(b), the examiner states on page 4 of the Examiner's Answer that Belke, Jr., et al teach a structure "...for secure holding of the connection wire, or pin." And adds to this statement that for the recitation "for secure holding" it "...is not seen to claim any structure that prevents the reference from being used for the same purpose as the intended use recitations of the claim

REPLY

Both claims 50 and 52 are method claims so that the "structure" referred to by the examiner is not necessary. The recited steps of the method defined in claim 50 include that of drilling through the floor of the blind bore so that the narrowed bore formed by the drilling through the floor of the blind bore "forms a holding mechanism." Belke, Jr. et al teaches an aperture 212 and a further aperture 214, followed by a third bore 215. Aperture 215 is smaller than apertures 212 and 214 and its purpose is to hold the solder slug 36 (col. 9, lines 4 - 10 of Belke, Jr. et al. Belke, Jr. et al does not teach any more. It does not teach that the diameter formed by drilling through the floor of the blind bore is dimensioned to be narrower than the diameter of the wire or pin. The important consideration is not the structure as it is the step of how the drilling nis to be performed.

A method is claimed, and if the method is to be rejected for anticipation, the steps of the method must be anticipated, not the structure.

EXAMINER"S ANSWER

On page 7 of the Examiner's answer, the examiner states "The circuit

board of Belke Jr., et al is capable of securely holding a connection wire, or pin."

REPLY

In ***Titanium Metals Corp. v. Banner***, 227 USPQ 773 (Fed. Cir. 1985) the Federal Circuit instructed us that "anticipation under Section 102 can be found only if a reference shows exactly what is claimed..." The Federal Circuit repeated itself in the case of ***In re Bond***, 15 USPQ2d 1566 (Fed. Cir. 1990), cited in our Brief on Appeal. This is now well settled law. Applying this instruction here leads, it is respectfully submitted, to the conclusion that anticipation is not proper against the claims on appeal because the "exactness" required is not present. What a reference is "capable of" is not the inquiry, what it actually teaches is.

EXAMINER"S ANSWER

On page 5 of the Examiner's Answer, the examiner again assumes that Kokubun et al teaches receiving a connection wire or pin in the stepped hole 6.

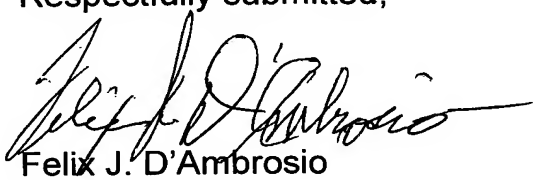
REPLY

We must again emphasize that Kokubun et al does not mention a connection wire or pin. It may be that a connecting wire and/or pins are used, but they do not have to be, and unless it is specifically stated that they are used, then we cannot assume that they are. One can argueb that connecting wires and pins are to be expected in this art. But, Kokubun et al also teaches an internal layer wiring pattern 4 is provided, without disclosing how a connection is made. Perhaps with a pin, but maybe not. We do not know, and that is the point which precludes assumptions. Where options are available, we need to be guided as to which option to choose. We have no such guidance in either Kokubun et al or Machida. The references must be enabling on the option. See, ***Beckman***

Instruments, Inc. v. LKB Produkter AB, 13 USPQ2d 1301 (Fed. Cir. 1989). The Federal Circuit instructed us to consider whether a reference is enabling, not from the standpoint of the disclosure of the invention being claimed, but from the standpoint of what the reference(s) teach. If there is no enablement in the teaching relied upon from the refeence, then the reference is not acceptable for a rejection under 35 USC 103.

The Board is urged to consider the above in making its deliberation as to the patentabilty of claims 50 - 52.

Respectfully submitted,



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